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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID K. GIFFORD

Appeal 2008-000884
Application 09/711,511
Technology Center 3600

Decided: June 23, 2010

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE¹

David K. Gifford (Appellant) has filed a Request for Rehearing, on Nov. 11, 2009, of the Decision mailed Sep. 11, 2009, reversing pro forma the rejection of claims 1-4 and 23 under 35 U.S.C. §103(a) as being unpatentable over Bush and Alantec and entering a new ground of rejection of claims 1-4 and 23 under 35 U.S.C. § 112, second paragraph. The Appellant seeks the withdrawal of the §112, second paragraph rejection and, as a consequence, to have the Board address the §103(a) rejection previously briefed.

In accordance with 37 C.F.R. § 41.52(a)(1), the Request includes certain points, in particular, that the Appellant believes the Board misapprehended or overlooked in reaching its Decision to enter a new ground of rejection under 35 U.S.C. § 112, second paragraph. The Appellant challenges the Board's basis for entering the §112, second paragraph rejection; that is, the Appellant challenges the finding that,

[T]he Specification does not adequately describe an algorithm corresponding to the function "purchase means responsive to a user request for communicating a purchase message to a merchant computer" [(claim 4)]. The Specification fails to disclose an algorithm corresponding to the recited function at issue in claim 4 such that one of ordinary skill in the art could determine the scope of claim 4.

Decision 15.

We have reviewed the Request in its entirety but do not find that the Appellant has shown the Board to be in error in deciding to enter a new

¹ Our decision will make reference to the Appellants' Request for Rehearing (filed Nov. 11, 2009, "Request") and the BPAI Decision (mailed Sep. 11, 2009, "Decision").

ground of rejection under 35 U.S.C. § 112, second paragraph, and as a consequence, to reverse pro forma, the §103(a) rejection. Our reasons are enumerated in the DISCUSSION section below.

DISCUSSION

In challenging to the Board's basis for entering the §112, second paragraph rejection, the Appellant disagrees that the disclosure, at p. 13, l. 13 - p. 14, l. 8 and Fig. 4, does not adequately describe an algorithm corresponding to the function "[purchasing via] respon[ding] to a user request for communicating a purchase message to a merchant computer" of the means-plus-function limitation "purchase means responsive to a user request for communicating a purchase message to a merchant computer" (claim 4) such that one of ordinary skill in the art could determine the scope of claim 4. Request 3.

We had reviewed the disclosure, at p. 13, l. 13 - p. 14, l. 8 and Fig. 4, of the Specification but were unable "to discern the algorithm." Decision 11. The Appellant argues that the algorithm can be discerned from the sentence, "[w]hen the user activates link 5, an HTTP request 25 is sent to the merchant computer requesting the document" [Specification, p. 13, ll. 21-23, referring to elements on Fig. 6] and Fig. 6. Request 4-5. According to the Appellant, these disclosures

clearly identify as proper structure an algorithm corresponding to the function of "[purchasing via] respon[ding] to a user request for communicating a purchase message to a merchant computer" [claim 4] in combination of a flowchart and prose, which forms are expressly authorized by *Finisar* [*Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1340-41 (Fed. Cir. 2008)].

Request 5. But we do not see any algorithm in the sentence “[w]hen the user activates link 5, an HTTP request 25 is sent to the merchant computer requesting the document”.

We quoted *Finisar* to show that the court “permits a patentee to express that algorithm in any understandable terms including as a mathematical formula, in prose ... or as a flowchart, or in any other manner that provides sufficient structure,” *Id.* Decision 5. Accordingly, the Board was not unaware that the Specification could provide adequate disclosure of an algorithm corresponding to the function “[purchasing via] respon[ding] to a user request for communicating a purchase message to a merchant computer” of the means-plus-function limitation “purchase means responsive to a user request for communicating a purchase message to a merchant computer” (claim 4) such that one of ordinary skill in the art could determine the scope of claim 4 in any understandable terms. Accordingly, our position that sufficient structure corresponding to the function recited in the claim 4 means-plus-function limitation at issue is not adequately disclosed was not one that was based on form but instead one based on substance. We were unable to determine the algorithm notwithstanding the prose at p. 13, l. 13 - p. 14, l. 8 and the flowchart in Fig. 4 of the Specification.

The sentence “[w]hen the user activates link 5, an HTTP request 25 is sent to the merchant computer requesting the document” [Specification, p. 13, ll. 21-23, referring to elements on Fig. 6] and Fig. 6 that the Appellant focuses on do not change our view. We are unable to discern from this disclosure the structure corresponding to the function “[purchasing via] respon[ding] to a user request for communicating a purchase message to a

merchant computer” (claim 4). What exactly is doing the “[purchasing via] respon[ding] to a user request for communicating a purchase message to a merchant computer”? Is it “link 5”? What is “link 5”? Even if we assume link 5 is a hyperlink, is it structurally anything but a hyperlink? Also, HTTP request 25, what is that? No information is given about what that request contains. Is it the combination of the link 5 and the HTTP request 25? We know nothing more from this other than when a “user activates link 5, an HTTP request 25 is sent to the merchant computer requesting the document.” We do not know, structurally-speaking, what is doing the “[purchasing via] respon[ding] to a user request for communicating a purchase message to a merchant computer” (claim 4). At best, the sentence describes a user activating a hyperlink that causes an HTTP request to be sent to a merchant computer requesting a document. As we stated in the Decision,

These disclosures explain what the purchase means is expected to do in the context of the invention. In effect, the Specification repeats, in different words, the function at issue.

Decision 12.

The more precise question is whether *one of ordinary skill in the art at the time of the invention* could adequately discern an algorithm from the prose at p. 13, l. 13 - p. 14, l. 8 and the flowchart in Fig. 4 of the Specification corresponding to the “[purchasing via] respon[ding] to a user request for communicating a purchase message to a merchant computer” (claim 4). *See* Decision 12. We found “there is no evidence on the record that one of ordinary skill in the art at the time of the invention would understand what this algorithm would be.” Decision 12.

The Appellant argues that

The algorithm disclosed in these portions of the specification involves responding to a specific type of user communication mechanism, that is a hyperlink on a user's displayed web document, and formatting the message according to a specific type of protocol, that is HTTP, as well as specifying that the content of the message is created to request a specific document: "When a user activates link 5, an HTTP request 25 is sent to the merchant computer requesting the document."

In other words, the disclosed algorithm which corresponds to the function at issue is very specific: hyperlinks having specific URLs are activated and are responded to, the communication message is formatted according to the HTTP protocol, the algorithm creates the message with specific content for requesting a specific document, etc.

Request 5. But the Specification makes no mention of a mechanism by which a specific URL is activated and responded to whereby a communication message is formatted according to an HTTP protocol thereby creating a message with specific content for requesting a specific document. All that is disclosed is a link 5 to be activated and, once activated, an HTTP request 25 is then sent to a merchant computer requesting a document. The precise mechanism underlying this operation is not disclosed.

To the extent the Appellant means to argue that one of ordinary skill in the art at the time of the invention would have understood the precise mechanism underlying the operation described by the sentence "[w]hen the user activates link 5, an HTTP request 25 is sent to the merchant computer requesting the document," as the Appellant has explained it, we find insufficient evidence to support it. (In that vein see discussion at Decision pages 13-15 about software architecture based on known conventions of the World Wide Web disclosed in the Specification.) Attorney's argument

cannot take the place of record evidence. *See also In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1581 (Fed. Cir. 1989). We have not been placed in a position to find that one of ordinary skill in the art at the time of the invention would have understood the precise mechanism underlying the operation described by the sentence from the Specification that the Appellant focuses on. The disclosure, as it is, leads us to the opposite conclusion.

CONCLUSION

We have carefully considered the arguments that the Appellants have set forth in the Request but, for the foregoing reasons, we do not find them persuasive as to error in the decision to reverse pro forma the rejection of claims 1-4 and 23 under 35 U.S.C. §103(a) as being unpatentable over Bush and Alantec and enter a new ground of rejection of claims 1-4 and 23 under 35 U.S.C. § 112, second paragraph.

DENIED

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